



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,533	12/11/2001	Andrew J. Fish	10559-628001/P11062	4295

8791 7590 07/21/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

CHEN, TSE W

ART UNIT	PAPER NUMBER
----------	--------------

2116

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/015,533

Applicant(s)

FISH ET AL.

Examiner

Tse Chen

Art Unit

2116

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST-REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed June 30, 2006 have been fully considered but they are not persuasive. Applicant argues that EFIS "does not teach or suggest that the firmware extension can reside on a self-describing boot device that has an unknown protocol for accessing the operating system or OS loader portion". Examiner disagrees and submits that the features upon which applicant relies (i.e., EFI OS loader accessed via unknown protocols) are not recited in the rejected claim(s). Moreover, Examiner was not able to find enabling means for handling unknown protocols in the original disclosure. Applicant argues that "it is inherent in [Harmer's] teachings that the system BIOS contains enough information to read the mass storage device... in contrast, Applicant's claimed invention recites that the information needed to read the required data from the media device is read from the media device (self-describing)". Examiner disagrees and submits Applicant's own definition of "self-describing" as "a basic input/output system [BIOS], which cannot read an entire media containing an OS because the OS uses an unknown format... the [BIOS] can read a portion of the media, and this portion enables reading of the remainder of the media" [pg.8-9 of Remarks dated June 30, 2006] in corresponding to Harmer's teachings [fig.5, 6a; col.11, ll.25-55]. Moreover, Examiner was not able to find enabling means other than BIOS for reading from the media device the information needed to read the required data from the media device in the original disclosure. Applicant alleges that BIOS Updates "fails to teach or disclose that the system has an extensible firmware interface". Examiner submits that EFIS, not BIOS Updates, was cited in the combined rejection to teach extensible firmware interface. Applicant alleges that Rakavy does not teach "a system with an EFI architecture where the EFI enables extension of platform firmware..." Examiner submits that EFIS, not Rakavy, was cited in the combined rejection to teach extensible firmware interface. Applicant alleges that Rakavy "teaches away from ... self-describing machine readable medium" with "a bootstrap loader... retrieved during POST from a predetermined location". Examiner disagrees and submits that Rakavy did not disclose explicitly that the bootstrap loader cannot be retrieved from a location determined by accessed data. Applicant alleges that Rakavy does not teach "that these optional hardware devices are self describing, or that they are also contain a portion of the operating system... can be the boot device". Examiner submits that Harmer, not Rakavy, was cited in the combined rejection to teach those limitations. As such, Applicant's arguments are deemed not persuasive and the rejections are respectfully maintained..